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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,487	04/29/2005	Bernd Eigenmann	18832	4030
23389 7590 10/22/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
			EXAMINER EDWARDS, NEWTON O	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 10/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/533,487

Applicant(s)

EIGENMANN ET AL.

Examiner

N Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/29/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6, 7, and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 6,7,8 are directed to the "Use of..." which does not encompass any statutory subject matter.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to for failing to provide an adequate written description of the invention as claimed.

The specification as filed fails to set forth 1) what defined or constitute a C long fibers of claim 1. How long is C long fibers or what is the length of the C long fibers of claim1? 2) What is the thickness range encompassed by claim 5.

Claims1-8 are rejected under 35 USC 112, first paragraph, for the reason given above in the objection.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6,7, and 8 are overall vague and indefinite since there are unclear as to whether the intended use refers to a method, composition, or apparatus of using. To overcome this rejection simply cancel the claims in question.

Claim 1 Lines 1,2,3,5,and 6 "C long fiber" is indefinite and vague to the meaning of the phrase.

Claim 1, lines 3-8 overall is indefinite and vague since it is directed to a triple inclusion (three different methods of make a C long fiber).

Claim 5, lines 2-3 "thickness..some nm and some um" is indefinite and vague as to the meaning of the phrase.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Akutagawa (JP 358107435 A).

For the record, the invention defined in a product by process claim is a **PRODUCT**, not a process. IN re Bridgeford, 357F.2d 679. It is the patentability of the product claimed and **NOT** of the recited process steps which must be established. In re Brown, 459 F. 2d 521. In re Wertheim, 451 F. 2d 257. Thus, the product invention defined by product by process claims 1-5 is a Mg (magnesium) material having a matrix with C long fiber(s) reinforcement wherein the fiber(s) has a thickness of any nm to any micron(um). Akutagawa teaches a carbon fiber- reinforced composite metal material in which the metal material is magnesium alloy.

The Primary Examiner has a reason to believe that Akutagawa carbon fiber(s) has the same thickness as claimed due to the same structural (carbon fiber made by Chemical vapor deposition) as claimed.

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shindo (US 4,731,298).

For the record, the invention defined in a product by process claim is a **PRODUCT**, not a process. IN re Bridgeford, 357F.2d 679. It is the patentability of the product claimed and **NOT** of the recited process steps which must be established. In re Brown, 459 F. 2d 521. In re Wertheim, 451 F. 2d 257. Thus, the product invention defined by product by process claims 1-5 is a Mg (magnesium) material having a matrix with C long fiber(s) reinforcement wherein the fiber(s) has a thickness of any nm to any micron(um). Shindo teaches a magnesium alloy composite having reinforced long (yarn) carbon fibers having a thick in the um (micron) range. See col.1 lines 5-60, examples, and claim 6, for example.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kalnin (US 4,056,874).

For the record, the invention defined in a product by process claim is a **PRODUCT**, not a process. IN re Bridgeford, 357F.2d 679. It is the patentability of the product claimed and **NOT** of the recited process steps which must be established. In re Brown, 459 F. 2d 521. In re Wertheim, 451 F. 2d 257. Thus, the product invention defined by product

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by process claims 1-5 is a Mg (magnesium) material having a matrix with C long fiber(s) reinforcement wherein the fiber(s) has a thickness of any nm to any micron(um). Kalnin teaches a continuous (long) carbon fiber reinforced magnesium alloy composite. See abstract, col.3 lines 35-40 and lines 5-8. Kalnin further teaches the composite magnesium alloy can be used in car engines such a turbine fan blades and armor plates (projectiles) at col. 7 line 59-end.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Towata (US 4,732,779) or Yamada (US 4,961,990).

For the record, the invention defined in a product by process claim is a **PRODUCT**, not a process. IN re Bridgeford, 357F.2d 679. It is the patentability of the product claimed and **NOT** of the recited process steps which must be established. In re Brown, 459 F. 2d 521. In re Wertheim, 451 F. 2d 257. Thus, the product invention defined by product by process claims 1-5 is a Mg (magnesium) material having a matrix with C long fiber(s) reinforcement wherein the fiber(s) has a thickness of any nm to any micron(um). Both Towata and Yamada, both Kabushiki patents, are applied together since there disclosures are substantially the same. Both Towata and Yamada teach a metal composite material such as magnesium alloy or aluminum alloy reinforced with continuous fiber or long fibers made from carbon (long carbon fibers).


The cited patents disclose the state of the prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to N Edwards whose telephone number is 571-272-1521.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



N Edwards  
Primary Examiner  
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